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Paper No.

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| In re Application of                   | : | OFFICE OF PETITIONS |
| Vesely and De Simone                   | : |                     |
| Application No. 10/644,787             | : | DECISION REFUSING   |
| Filed: August 21, 2003                 | : | STATUS UNDER        |
| Title of Invention:                    | : | 37 CFR 1.47         |
| STRAINS OF BACTERIA AND PHARMACEUTICAL | : |                     |
| COMPOSITION CONTAINING ONE OR MORE OF  | : |                     |
| SUCH STRAINS AND USE OF SAME FOR       | : |                     |
| PREVENTING AND TREATING DISEASES       | : |                     |
| ASSOCIATED WITH OR CAUSED BY ALTERED   | : |                     |
| METABOLISM OF BILE ACIDS               | : |                     |

This is in response to a petition under 37 CFR 1.47(a), filed March 4, 2004, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s), and also in response to the "Response to Second Notice to File Missing Parts of Nonprovisional Application", filed with the instant petition.

**The rule 47 petition**

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)", and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on August 21, 2003, without an oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on January 21, 2004, requiring *inter alia*, an executed oath or declaration.

In response to the Notice, Applicant files the instant petition under 37 CFR 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventors. Applicants aver that the nonsigning inventor was sent a declaration for execution on March 3, 2004.

Applicants subsequently received a letter from putative legal counsel for the nonsigning inventor, indicating that the nonsigning inventor would not sign the declaration.

#### Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1).

As to item (1),

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It

is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

MPEP 409.03(d)

The MPEP further provides that

[w]here a written refusal to join in the application is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. (Emphasis supplied). The document may be redacted to remove material not related to the inventor's reasons for refusal.

Id.

### **Conclusion**

Applicant must attempt to present a copy of the application papers to the inventor, and in this instance provide a copy of any documents evidencing a refusal to join in the application.

**The Response to Second Notice to File Missing Parts of  
Nonprovisional Application**

Applicant also files a Response to Second Notice to File Missing Parts of Nonprovisional Application, wherein Applicant notes a second Notice to File Missing Parts of Application was mailed in this application on April 1, 2004, which requires a new oath identifying this application number because the oath allegedly does not identify the residence and citizenship of each inventor. Applicant argues that the oath/declaration [filed March 22, 2004] provides the residence and citizenship of each inventor and otherwise complies with the MPEP 605.04. A review of the oath/declaration filed March 22, 2004 reveals that Applicant is correct.

The second Notice to File Missing Parts of Application, mailed April 1, 2004, was mailed in error and is hereby withdrawn.

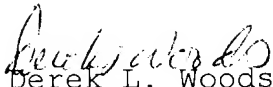
Further correspondence with respect to this matter should be addressed as follows:

By mail:            Director for Patents  
                    PO Box 1450  
                    Alexandria, VA 22313-1450

By FAX:            (703) 872-9306  
                    Attn: Office of Petitions

By hand:           2201 South Clark Place  
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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

  
Derek L. Woods  
Petitions Attorney  
Office of Petitions